

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Valerie M. Bennett, et al.

January 21, 2009

Serial No.: 10/733,985

Filed: December 11, 2003

For: Customized Subscription Builder

Art Unit: 3622

Examiner: Rodney M. Henry

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an Appeal seeking reversal of the decision of the Primary Examiner, finally rejecting all current claims of the subject patent application.

1) REAL PARTY IN INTEREST

The real party in interest is the Assignee, International Business Machines Corporation ("IBM").

2) RELATED APPEALS AND INTERFERENCES

Related application serial number 10/733,625 was the subject of a Notice of Appeal filed October 8, 2008. A Pre-Appeal Brief was filed on the same date. A Notice of Panel Decision from Pre-Appeal Brief Review dated December 16, 2008, indicated that a conference had been held and that prosecution was being reopened, thereby obviating the Notice of Appeal.

Appellants, the Appellants' legal representative, and the assignee, have no personal knowledge of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3) STATUS OF CLAIMS

Claims 1 - 6 and 12 stand rejected. Claims 7 - 11 were previously canceled. Claims 1 - 6 and 12 are under appeal.

4) STATUS OF AMENDMENTS

An Amendment After Final was filed on August 20, 2008, responsive to the final Office Action mailed on June 23, 2008. The Amendment After Final included no amendments to the Application, and the Amendment After Final was considered by the Examiner, according to the Advisory Action dated September 19, 2008. There are no unentered amendments to the

Application. A Pre-Appeal Brief Request for Review was filed on October 17, 2008.

5) SUMMARY OF CLAIMED SUBJECT MATTER

1. In a first aspect, Appellants claim a method of selectively subscribing to content in a computing environment (Claim 1, lines 1 - 2; Specification, p. 16, lines 1 - 5). From a rendered view of content, a user is enabled to identify a portion of the content which is of interest to the user (Claim 1, lines 3 - 4; Specification, p. 6, lines 7 - 9, p. 20, lines 9 - 16; Fig. 15, trigger handler 1540; Fig. 10; Fig. 7). The renderer of the view of the content has not provided a subscription interface to this content; that is, the provider of the content has not provided a way to subscribe to the content that is included with the content (Claim 1, lines 4 - 5; Specification, p. 6, lines 11 - 13). The invention registers a subscription to the portion of the content identified by the user on behalf of the user (Claim 1, line 6; Specification, p. 6, lines 9 - 10, p. 21, lines 14 - 17, Fig. 15, content matching engine 1570; Fig. 9).

2. In another aspect of the invention per dependent Claim 2, the method uses the registered subscription to deliver updates of the identified portion of the content to the user (Claim 2, lines 2 - 3; Specification, p. 21, lines 17 - 19; p. 22, line 1 - p. 26, line 14; Figs. 10 - 14).

3. In another aspect, Appellants claim that the method of Claim 1 enables the user to customize the subscription to specify at least one condition which must be matched before the user is interested in the identified portion of the content (Claim 3, lines 2 - 3; Figure 4; Specification, p. 13, lines 9 - 15, p. 14, line 15 - p. 15, line 13). The registering also comprises

registering the customization (Claim 3, line 4; Figure 4; p. 13, lines 9 - 15, p. 32, lines 8 - 10).

4. The method further uses the registered subscription to deliver to a user an update of the identified portion of the content. This content matches condition(s) specified by the user (Claim 4, lines 2 - 3; Figures 10 - 12; Specification, p. 7, lines 14 - 19; p. 17, lines 10 - 15, p. 24, line 9 - p. 25, line 3).

5. The method further includes specifying at least one action to be carried out when the condition(s) is matched in an update of the identified portion of the content. (Claim 5, lines 2 - 3; Figures 7 and 15, element 1511; Specification, p. 17, line 16 - p. 19, line 1, p. 24, line 9 - p. 25, line 8).

6. According to Claim 6, the method of Claim 5 further includes evaluating the registered subscription. If at least one registered condition is determined to be met in an update to the identified portion of the content, the action(s) is carried out. (Claim 6, lines 2 - 3; Figures 11 and 15, element 1511; Specification, p. 22, lines 11 - 20, p. 24, line 21 - p. 25, line 8).

7. Per Claim 12, the enabling (Claim 12, line 1; Specification, p. 6, lines 7 - 9, p. 20, lines 9 - 16; Fig. 15, trigger handler 1540; Fig. 10; Fig. 7) and the registering (Claim 12, line 2; Specification, p. 6, lines 9 - 10, p. 21, lines 14 - 17, Fig. 15, content matching engine 1570; Fig. 9) are adapted for enabling multiple users (Claim 12, line 2; Specification, p. 7, lines 1 - 3) to identify the portion of content which is of interest to each of them. The method registers the subscription

to the identified portion of the content for each of the users. (Claim 12, lines 2 - 4; Figure 15, element 1511; Specification, p. 7, lines 1 - 3).

6) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

8. The **Grounds of Rejection** presented for review is a rejection of Claims 1 - 6 and 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,731,393 to Currans et al. (hereinafter, "Currans"), according to the Office Action mailed June 23, 2008 (hereinafter, "the Office Action") and as further discussed in the Advisory Action mailed September 19, 2008 (hereinafter, "the Advisory Action").

7) ARGUMENT

9. The Court of Appeals for the Federal Circuit has stated that a finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In another case, the Court of Appeals for the Federal Circuit held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

10. Furthermore, in a subsection of MPEP §2131 titled "TO ANTICIPATE A CLAIM, THE

REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM”, a Federal Circuit holding is quoted which states “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

11. Appellants will demonstrate, below, that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out as to their Claims 1 - 6 or 12, as the reference cited for each of these claims does not disclose, teach or suggest all of the claim elements of these claims.

7.1) Grounds of Rejection

12. Paragraph 3 of the Office Action states that Claims 1 - 6 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,731,393 to Currans et al. (hereinafter, “Currans”), according to the Office Action. Of these, the independent claim is Claim 1. These claims have been discussed above in “**5) Summary of Claimed Subject Matter**”.

7.1.1) Rejection of Independent Claim 1

13. Referring first to independent Claim 1, Appellants respectfully submit that Currans does not disclose all of the claim elements recited therein, as will now be demonstrated.

14. The first element of independent Claim 1 recites “enabling a user to identify, from a rendered view of content, a portion of the content which is of interest to the user”. Relative to

this subject matter, the Office Action cites column 13, lines 55-57 of Currans. This passage states that “[n]ote that this document is a user’s personalized newspaper which contains information in which the user has indicated a specific interest in, as stored in the user profile in knowledge module 170.” The document 1300 is a document (personalized newspaper) that has already been printed by a printing device (column 13, lines 53 - 54). There is no teaching or disclosure in this passage of a user identifying a portion of content from a rendered view. The ‘rendered document’ of Currans is a printed document. Rather, the Currans document (the personalized newspaper) is created and printed based on an interest stored in a user profile. No disclosure is relative to a user being enabled to indicate an interest in a portion of the content of the document. Certainly, there is no disclosure of this being carried out from a rendered view of the content. No rendered view of content *from which* a user specifies an interest in a portion thereof is taught or disclosed. *How the user in Currans indicates or identifies a specific interest in any portion is not described.* Currans simply does not suggest, disclose or teach this subject matter.

15. The first element of Claim 1 further recites “wherein a renderer of the view of the content has not provided a subscription interface thereto”. Relative to this subject matter, the Office Action cites column 7, lines 23 - 27. This passage states that “[i]t should be noted that although depicted as an element of edit module 120, those skilled in the art will appreciate that content manager 518 may well be deployed as an [sic] separate and independent functional entity”. Edit module 120 as illustrated in Figure 13 includes a virtual editor 506 which includes the content manager 518. Relative to the content manager 518, Currans simply states in column 6, lines 47 - 53 “virtual editor 506 includes a content manager 518 ... [a]s the editor module 120 receives

content from one or more content providers, content manager 518 is selectively invoked by controller[s] 502.” The content manager 518 includes an analysis agent 522, a contract administrator function 524 and a transaction agent 526. Further, in column 14, lines 12 - 31, Currans describes how the generator module receives content objects from content providers 50 and/or advertising providers 80 and invokes an instance of the content manager 518, which classifies, wraps and store each of the received content objects. The content manager 518 invokes an instance of analysis/wrapper agent 522 to analyze and encapsulate the received content object in a trace wrapper. The content manager 518 then updates the content provider information data structure 620 associated with the provider of the content object to denote the wrapper identifier for the received content object.

16. In Currans’ description and discussions of the content manager 518, there is absolutely no discussion that the content manager 518 is employed in connection with enabling a user to identify a portion of the content which is of interest to the user. Instead, the content manager 518 apparently manages the presentation of content to the user and does not assist in enabling a user to identify content of interest, either with or without a subscription interface. Further, there is no correlation between this function and the document 1300 of Currans which is cited relative to the prior portion of Claim 1 discussed above in numbered Paragraph 14. The document 1300 is a printout. Accordingly, Applicants submit that Currans does not teach, suggest or disclose this subject matter from Claim 1.

17. Claim 1 further recites “registering a subscription ... to the identified portion of the

content”. Relative to this subject matter, Fig. 5 of Currans is cited. Figure 5 appears to show a page of a type commonly found on the Internet which permits a user to register with a website and download and install software.

18. First, as discussed above, the user in Currans does not identify a portion of rendered content. Second, the web page illustrated in Fig. 5 is not the printed document 1300, which was employed in the Office Action to disclose rendered content and selection of a portion thereof. Third, no subscription is registered of the identified portion of rendered content. As stated in the Office Action, Figure 5 shows “registration for an offer to win” and “free instant delivery download registration”. But the term registration is not found in Figure 5 or its description in the Specification. The term subscription is well defined in the present invention. Further, Figure 5 does not teach, suggest or disclose registration of a subscription. The discussion of Figure 5 in Currans does not use the word subscription, and nothing in context of a subscription per the present invention is found in Currans. Currans states that “Fig. 5 shows a very simply [sic] acquisition of user profile data” (column 9, line 30). A user can enter a contest. A user can download free software. Relative to Figure 5, Currans goes on to state that “only three pieces of information are stored in the user profile: type of printer, email address, and whether HP can contact the user” (column 9, lines 34 - 36). Clearly, no registration of a subscription to an identified portion of content is taught or disclosed by Figure 5. Rather, user information is gathered.

19. Clearly, the anticipation rejection under 35 U.S.C. §102 over Currans fails to meet the

requirements as put forth by the Court of Appeals for the Federal Circuit. As indicated above, Currans does not disclose each and every limitation of Claim 1. Appellants have demonstrated above that differences exist between Claim 1 and Currans.

20. In view of the above, Appellants respectfully submit that differences exist between their invention as claimed in Claim 1 and the teachings of Currans; therefore, Currans does not anticipate Claim 1 according to the holding in *Scripps Clinic*. Stated another way, Currans and its features do not have absolute identity for each and every claim element recited in Appellants' Claim 1, and Claim 1 is therefore not anticipated by Currans according to *Trintec Indus.* And, because Currans does not teach each and every element as set forth in Claim 1, Currans does not anticipate Claim 1 according to *Verdegaal Bros.*, which is quoted in MPEP §2131.

21. Without more, independent Claim 1 is deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

7.1.2) Rejection of Dependent Claim 2

22. While dependent Claims 2 is deemed allowable by virtue of the allowability Claim 1 from which it depends, Claim 2 stands or falls by itself should Claim 1 be deemed to be unallowable.

Appellants respectfully submit that Currans does not disclose all of the claim elements recited therein, as will now be demonstrated.

23. Claim 2 recites “using the registered subscription to deliver updates of the identified portion of content to the user.” Relative to this subject matter, a passage from column 13, lines 19 - 20 and Figure 11 are cited. This passage simply states that “Edit module 120 examines the user’s interests as specified in the user profile stored in knowledge module 170 to assemble the document from selected content providers 50”. Once again, “identified portions of content” per the present invention is not disclosed in this passage of Currans. Updates to the identified portions are not disclosed. Rather, based on a user profile, a document is assembled from selected providers. Figure 11 illustrates a document printed by a printing device.

24. In view of the above, Appellants respectfully submit that differences exist between their invention as claimed in Claim 2 and the teachings of Currans; therefore, Currans does not anticipate Claim 2 according to the holding in *Scripps Clinic*. Stated another way, Currans and its features do not have absolute identity for each and every claim element recited in Appellants’ Claim 2, and Claim 2 is therefore not anticipated by Currans according to *Trintec Indus.* And, because Currans does not teach each and every element as set forth in Claim 2, Currans does not anticipate Claim 2 according to *Verdegaal Bros.*, which is quoted in MPEP §2131.

25. Without more, independent Claim 2 is deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

7.1.3) Rejection of Dependent Claims 3 - 6 and 12

26. Dependent Claims 3 - 6 and 12 stand or fall with the allowability of Claim 1 from which they depend. Thus, these dependent claims are deemed allowable by virtue of the allowability of independent Claim 1, the patentability of which is discussed above in “**7.1.1) Rejection of Independent Claim 1**”.

8) CONCLUSION

For the reasons set out above, Appellants respectfully contend that each appealed claim is patentable, and respectfully request that the Examiner’s Final Rejection of appealed Claims 2, 10 and 26 be reversed.

Respectfully submitted,

/Marcia L. Doubet/

Marcia L. Doubet,
Attorney for Appellants
Reg. No. 40,999

Customer Number for Correspondence: 43168
Phone: 407-343-7586
Fax: 407-343-7587

CLAIMS APPENDIX

CLAIMS AS CURRENTLY PRESENTED:

1 Claim 1: A method of selectively subscribing to content in a computing environment, comprising:
2 enabling a user to identify, from a rendered view of content, a portion of the content
3 which is of interest to the user, wherein a renderer of the view of the content has not provided a
4 subscription interface thereto; and
5 registering a subscription, for the user, to the identified portion of the content.

1 Claim 2: The method according to Claim 1, further comprising:
2 using the registered subscription to deliver updates of the identified portion of the content
3 to the user.

1 Claim 3: The method according to Claim 1, further comprising:
2 enabling the user to customize the subscription to specify at least one condition which
3 must be matched before the user is interested in the identified portion of the content; and
4 wherein the registering further comprises registering the customization.

1 Claim 4: The method according to Claim 3, further comprising:
2 using the registered subscription to deliver an update of the identified portion of the
3 content which match the at least one condition to the user.

1 Claim 5: The method according to Claim 3, further comprising:

2 specifying, for the user, at least one action to be carried out when the at least one
3 condition is matched in an update of the identified portion of the content.

1 Claim 6: The method according to Claim 5, further comprising:

2 evaluating the registered subscription, and if the at least one condition registered therein
3 is met in an update to the identified portion of the content, carrying out the at least one action.

1 Claim 12: The method according to Claim 1, wherein the enabling and the registering are
2 adapted for enabling a plurality of users to identify the portion of the content which is of interest
3 to each of the plurality of users and registering the subscription to the identified portion of the
4 content for each of the plurality of users, respectively.

EVIDENCE APPENDIX

Appellants, the Appellants' legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.

RELATED PROCEEDINGS APPENDIX

No related proceedings are personally known to Appellants, the Appellants' legal representative, or the assignee.